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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,021	08/06/2001	Yongmimg Sun	DEX-0150	7327

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EXAMINER
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ART UNIT	PAPER NUMBER
1642	

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12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/762,021	Applicant(s) Sun et al
	Examiner Ungar	Art Unit 1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *one* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Sep 27, 2001* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-11* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. Claims 1-11 are pending in the application and are currently under prosecution.

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Anthony Caputa, Ph.D., Supervisory Patent Examiner at 703-308-3995. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

It is noted that the specification defines CSG as the native protein expressed by genes comprising SEQ ID NOS 1, 2 or 3 as well as levels of native mRNA encoded by genes comprising SEQ ID NOS 1, 2 or 3 or levels of the gene comprising SEQ ID NO:1, 2 or 3. Therefore, the claims are restricted as defined.

2. This application contains the following inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13:

Group 1. Claims 1 and 6 are drawn to a method for diagnosing the presence of colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:1.

Group 2. Claims 1 and 6 are drawn to a method for diagnosing the presence of colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:2.

Group 3. Claims 1 and 6 are drawn to a method for diagnosing the presence of colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:3.

Group 4. Claims 1 and 6 are drawn to a method for diagnosing the presence of colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:1.

Group 5. Claims 1 and 6 are drawn to a method for diagnosing the presence of colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:2.

Group 6. Claims 1 and 6 are drawn to a method for diagnosing the presence of colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:3.

Group 7. Claims 1 and 6 are drawn to a method for diagnosing the presence of colon cancer in a patient comprising assaying for CSG gene comprising SEQ ID NO:1.

Group 8. Claims 1 and 6 are drawn to a method for diagnosing the presence of colon cancer in a patient comprising assaying for CSG gene comprising SEQ ID NO:2.

Group 9. Claims 1 and 6 are drawn to a method for diagnosing the presence of colon cancer in a patient comprising assaying for CSG gene comprising SEQ ID NO:3.

Group 10. Claims 2 and 6 are drawn to a method for diagnosing metastatic colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:1.

Group 11. Claims 2 and 6 are drawn to a method for diagnosing metastatic colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:2.

Group 12. Claims 2 and 6 are drawn to a method for diagnosing metastatic colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:3.

Group 13. Claims 2 and 6 are drawn to a method for diagnosing metastatic colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:1.

Group 14. Claims 2 and 6 are drawn to a method for diagnosing metastatic colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:2.

Group 15. Claims 2 and 6 are drawn to a method for diagnosing metastatic colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:3.

Group 16. Claims 2 and 6 are drawn to a method for diagnosing metastatic colon cancer in a patient comprising assaying for gene comprising CSG SEQ ID NO:1.

Group 17. Claims 2 and 6 are drawn to a method for diagnosing metastatic colon cancer in a patient comprising assaying for gene comprising CSG SEQ ID NO:2.

Group 18. Claims 2 and 6 are drawn to a method for diagnosing metastatic colon cancer in a patient comprising assaying for gene comprising CSG SEQ ID NO:3.

Group 19. Claims 3 and 6 are drawn to a method for staging colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:1.

Group 20. Claims 3 and 6 are drawn to a method for staging colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:2.

Group 21. Claims 3 and 6 are drawn to a method for staging colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:3.

Group 22. Claims 3 and 6 are drawn to a method for staging colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:1.

Group 23. Claims 3 and 6 are drawn to a method for staging colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:2.

Group 24. Claims 3 and 6 are drawn to a method for staging colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:3.

Group 25. Claims 3 and 6 are drawn to a method for staging colon cancer in a patient comprising assaying for gene comprising CSG SEQ ID NO:1.

Group 26. Claims 3 and 6 are drawn to a method for staging colon cancer in a patient comprising assaying for gene comprising CSG SEQ ID NO:2.

Group 27. Claims 3 and 6 are drawn to a method for staging colon cancer in a patient comprising assaying for gene comprising CSG SEQ ID NO:3.

Group 28. Claims 4-6 are drawn to a method for monitoring colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:1.

Group 29. Claims 4-6 are drawn to a method for monitoring colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:2.

Group 30. Claims 4-6 are drawn to a method for monitoring colon cancer in a patient comprising assaying for CSG protein expressed by SEQ ID NO:3.

Group 31. Claims 4-6 are drawn to a method for monitoring colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:1.

Group 32. Claims 4-6 are drawn to a method for monitoring colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:2.

Group 33. Claims 4-6 are drawn to a method for monitoring colon cancer in a patient comprising assaying for CSG mRNA encoded by SEQ ID NO:3.

Group 34. Claims 4-6 are drawn to a method for monitoring colon cancer in a patient comprising assaying for gene comprising CSG SEQ ID NO:1.

Group 35. Claims 4-6 are drawn to a method for monitoring colon cancer in a patient comprising assaying for gene comprising CSG SEQ ID NO:2.

Group 36. Claims 4-6 are drawn to a method for monitoring colon cancer in a patient comprising assaying for gene comprising CSG SEQ ID NO:3.

Groups 37-39. Claim 7 is drawn to antibodies against SEQ ID NO:1, 2 or 3, each of which is a distinct invention. It is noted for Applicant's

convenience that this is **not** an election of species requirement. Applicant is required to elect a single invention for examination.

Groups 40-42. Claims 8-9 are drawn to a method of imaging colon cancer comprising administering to a patient an antibody against SEQ ID NO:1, 2, or 3, each of which is a distinct invention. It is noted for Applicant's convenience that this is **not** an election of species requirement. Applicant is required to elect a single invention for examination.

Groups 43-45. Claims 10-11 are drawn to a method of treating colon cancer comprising administering to a patient an antibody against SEQ ID NO:1, 2, or 3, each of which is a distinct invention. It is noted for Applicant's convenience that this is **not** an election of species requirement. Applicant is required to elect a single invention for examination.

4. The inventions are distinct, each from the other because of the following reasons:

A national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. When claims to different categories are present in the application, the claims will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories: (1) A product and a process specially adapted for the manufacture of said product; or (2) A product and a process of use of said product; or (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or (4) A process and an apparatus or means specifically designed for carrying out the said process; or (5) A product, a process

specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application will be considered as the main invention in the claims, see PCT article 17(3) (a) and 1.476 (c), 37 C.F.R. 1.475(b) and (d). Group I will be the main invention. After that, all other products and methods will be broken out as separate groups (see 37 CFR 1.475(d).)

Groups 2-45 are drawn either to other processes or to products not used in the process of Group I.

5. Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of

each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (703) 305-2181. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995. The fax phone number for this Art Unit is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.

Susan Ungar
Primary Patent Examiner
November 8, 2002